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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,016	11/16/2001	Kirk Kobmann	OB008DH-1	2966

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EXAMINER	
PICKARD, ALISON K	

ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/991,016	KOBMANN ET AL.	
	Examiner	Art Unit	
	Alison K. Pickard	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-30 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsen.

Larsen discloses a non-symmetrical tub having plural fastening features/tabs, and heat expandable material. As seen best in Figure 4 (and col. 4, lines 33-37), the material 16, can be located about a periphery of the tub. Larsen discloses plural fasteners/tabs, only one of which is shown in the cross-section of Figure 4. Although Larsen does not specifically disclose the location of the fasteners or that they would engage at least two of the members to be sealed, such configuration is considered a design choice. See In re Dailey, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to configure the fasteners such that they engage the two members as a matter of choice in design.

3. Claims 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takabatake '914.

Takabatake discloses a sealing device comprising a non-symmetrical tub 31 having a locking feature 36 (weldable metal). Heat activated sealant 21 contacts the tub. The tub can be injection-molded (see col. 7, lines 58-60). The seal and sealant contacts at least three, metallic,

automotive members 1, 2, and 3 (Fig. 2). The sealant is located about a periphery of the tub. Takabatake does not disclose plural locking features. Using plural locking features is considered a design choice. See In re Harza 124 USPQ 378 (CCPA 1960). Multiple locking features would enhance the stability of the tub. And, it is known to use plural locking features with a sealing device as evidenced by Larsen. At least two of the members 1, 2, and 3 would be engaged with plural fasteners. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use plural locking features as a matter of choice in design.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsen.

Larsen does not disclose that the tub is made of polyethylene terephthalate. Making the tub from this material is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin,* 125 USPQ 416 (CCPA 1960). Polyethylene terphthalate is a known moldable material (as evidenced by Applicant, spec. page 4). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the component from polypropylene as a matter of choice in design.

5. Claims 2, 3, 6, 7, 9-12, 14-16, and 18-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamuro (5,829,824) in view of Larsen (6,419,305).

Yamamuro discloses three adjacent metallic automotive members 17 (or 15), 4, and 14 that form a cavity (see Fig. 2). The members comprise a floor pan 14, wheelhouse 4, and rail or sheet metal 15. Yamamuro does not disclose a cavity seal/pan extension or heat expandable sealant. Larsen teaches the use of a cavity seal between adjacent automotive members (col. 4, lines 1-16). The seal provides structural reinforcement and damping characteristics (i.e. for

noise, dust, etc.). Larsen teaches that the cavity sealer is an injection-molded component shaped to fit within the cavity formed by the automotive members. The sealer 14 is secured in place within the cavity by integral locking tabs (see Fig. 4) and then is sealingly secured to the members by a heat-activated sealant 16. The sealer 14 comprises a fiber-reinforced thermoset (see col. 9, line 54). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the body structure disclosed in Yamamuro by reinforcing the cavity formed by the three members with the cavity sealer taught by Larsen to reinforce the structure and offer damping characteristics against force, noise, etc.

Regarding claim 10 (and 16), Larsen discloses the component can be made from an injection-molded polymer. However, Larsen does not disclose that the component is formed from polypropylene. Making the component from polypropylene is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin,* 125 USPQ 416 (CCPA 1960). Polypropylene is a known rigid material used in sealing components as evidenced by Walser. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the component from polypropylene as a matter of choice in design.

6. Claims 12-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamuro in view of Takabatake in view of Larsen.

Yamamuro discloses at least two (three) adjacent metallic automotive members 17 (or 15), 4, and 14 that form a cavity (see Fig. 2). The members comprise a floor pan 14, wheelhouse 4, and rail or sheet metal 15. Yamamuro does not disclose a cavity seal/pan extension or heat expandable sealant. Takabatake teaches a cavity seal comprising a member 31 having a heat

expandable sealant 21. The member is non-symmetrical, has a cavity, and an opening (see between walls 83 in Fig. 6). The member includes a weldable insert 36. Takabatake teaches that the cavity seal is placed in a cavity formed by automotive members and offers damping power and sound insulation. Takabatake does not disclose that the material of the member 31 is a thermoplastic or that it comprises a compressible locking tab. Larsen teaches a cavity sealer that is held in place within a cavity by fasteners (seen in Fig. 4). Larsen also teaches that cavity seal has a member that can be made from a thermoplastic (nylon) material or metal. Thermoplastics can be injection-molded for easy manufacture. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Yamamuro in view of Takabatake and further in view of Larsen to provide a seal with a easily manufactured member that can be effectively mounted and retained within a cavity formed by adjacent auto members to offer damping power and sound insulation.

Regarding claims 16 and 17, Neither Larsen or Yamamuro disclose the sealant is ethyl vinyl acetate or that the thermoplastic is one of polyester, polypropylene or polyethylene terephthalate. Making the items from these materials is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended use. See *In re Leshin,* 125 USPQ 416 (CCPA 1960). These materials are known to be used for sealing elements in automobiles as evidenced by Walser and Hanley '260. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the sealant from ethyl vinyl acetate and to select the thermoplastic from one of polyester, polypropylene or polyethylene terephthalate as a matter of choice in design.

Response to Arguments

7. Applicant's arguments filed 10-6-04 have been fully considered but they are not persuasive.

Applicants' attempt to distinguish "into" and "within" from "between" is not persuasive. Also, the claims do not even use the word "between" (amended claims). The limitation that the sealant is "in contact with" the automotive components and the tub is met by all the references used in the rejections.

The argument that the material 16 of Larsen (and material 21 of Takabatake) does not extend around the periphery of the tub is unpersuasive. Larsen specifically states the sealant can be anywhere around the tub and Figure 4 clearly shows the sealant 15 at the periphery (see near line 14). Also, material 21 of Takabatake is located about a periphery and contacts all three components (seen best in Fig. 2). The limitation "around (or about) a periphery" does not imply the entire periphery.

It appears Applicant is arguing the references based on their perception of the invention (i.e. the figures, etc.) and not based on what is claimed. Described in simple terms, it appears Applicants' device would be used for a hole within a plane whereas the device(s) of the applied prior art are more for a hole or cavity between two planes. (Note: the examiner is aware that these particular components are not planar or within a flat plane. This is merely used for illustration.) And, it seems that Applicants' arguments (i.e. about "within" and "between") would support this description. However, this is not how the claims are written or interpreted. Therefore, the combinations used to reject the claims are proper for the invention as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 703-308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alison K. Pickard
Primary Examiner
Art Unit 3676

AP